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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,050	12/12/2003	Benjamin Atkin	51291/JEJ/D359	2484
23363 7590 11/27/2007 CHRISTIE, PARKER & HALE, LLP PO BOX 7068 PASADENA, CA 91109-7068			EXAMINER WILSON, JOHN J	
			ART UNIT 3732	PAPER NUMBER
			MAIL DATE 11/27/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/735,050

Applicant(s)

ATKIN ET AL.

Examiner

John J. Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rahman et al (6716028) in view of Cook et al (6623500). Rahman shows a hand piece 82, Figs. 11A-11D, for a transducer 14, a body 82b rotatably receiving a transducer, rotator head 80a engaging the transducer for rotation, means 80b for rotatably coupling the body 82b to the rotator head 80a. Rahman further shows that rotation of the rotator head rotates the transducer, column 9, lines 5-12. The rotator head of Rahman is inherently rotated by a force applied directly to it by other elements. Rahman shows locating the attachment portion of the locator head inside the body, and as such, does not show a rotor head that envelops at least a portion of the body. Cook shows an ultrasonic tool including a rotator head 200 that envelops at least a portion of a body 150. It would be obvious to one of ordinary skill in the art to modify Rahman to include locating the elements in reverse orientation so that the rotator head is on the outside as shown by Cook in that a mere reversal of the location of known elements is within the level of a skilled artisan.

Claims 1-4, 13, 14, 16-19 and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rahman et al (6716028) in view of Novak (6012922) and Cook et al (6623500). Rahman shows a hand piece 82, Figs. 11A-11D, for a transducer 14, a body 82b rotatably receiving a transducer, rotator head 80a that is coupled to the body 82b by fingers 80f so that the rotator head 80a along with the transducer insert will rotate with respect to the body 82b. The rotator head of Rahman is inherently rotated by a force applied directly to it by other elements. The shown coupling means of Rahman is not in the form of a ring. Novak teaches a rotatably connected rotator head 14 on body 15 and shows using a retainer ring 18, Figs. 2 and 5, to enable the relative rotation. It would be obvious to one of ordinary skill in the art to modify Rahman to include using a ring coupling means as shown by Novak in order to make use of known alternatives in the art for allowing elements to rotate with respect to each other. Rahman further shows that rotation of the rotator head rotates the transducer, column 9, lines 5-12. Rahman shows locating the attachment portion of the locator head inside the body, and as such, does not show a rotor head that envelops at least a portion of the body. Cook shows an ultrasonic tool including a rotator head 200 that envelops at least a portion of a body 150. It would be obvious to one of ordinary skill in the art to modify the above combination to include locating the elements in reverse orientation so that the rotator head is on the outside as shown by Cook in that a mere reversal of the location of known elements is within the level of a skilled artisan. As to claim 2, to use a metal ring is an obvious matter of choice in known materials used of coupling rings to the skilled artisan. As to claims 3 and 4, the location of the groove is an obvious matter

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of choice in the reversal of the location of known elements to one of ordinary skill in the art. As to claims 13 and 14, see column 1, line 33, of Rahman. As to claim 17, see coil, column 2, line 45 of Rahman. As to claim 18, see electric and fluid source, column 1, lines 25-30, of Rahman. As to claims 21 and 22, see nickel plates, column 1, line 42, of Rahman. As to claim 24, the rotation of the insert inherently applies a force to 80a, and as such, turning requires a force to the rotator head.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rahman et al (6716028) in view of Novak (6012922) and Cook et al (6623500) as applied to claim 1 above, and further in view of Coss et al (5655906). The above combination does not show using a plurality of grooves, claim 5, and slots, claim 6. Coss shows a plurality of grooves and slots as shown on the body 10 in Fig. 1. It would be obvious to one of ordinary skill in the art to modify the above combination to include grooves and slots as shown by Coss in order to improve the grip. That these structures may be used to mount a lock and hand grip is merely intended use, all the actual structure being shown, the intended use with inferentially claimed elements is not given patentable weight.

Claims 7-10, 20 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rahman et al (6716028) in view of Novak (6012922) and Cook et al (6623500) as applied to claim 1 above, and further in view of Carmona et al (3654502). As to claim 7, Rahman teaches use of a coil is known, however, does not specifically

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show a coil in the embodiments, and as to claim 8, does not show a coil mounted on a bobbin, and as to claim 9, does not show a sealing O-ring, and as to claim 10, does not show a cavity through the bobbin for fluid. Carmona teaches a coil 36, bobbin 16, O-ring 30 and fluid 66 within the bobbin. It would be obvious to one of ordinary skill in the art to modify the above combination to include the structures shown by Carmona in order to make use of known ways in the art to better mount a coil and provide fluid flow.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rahman et al (6716028) in view of Novak (6012922), Cook et al (6623500) and Carmona et al (3654502) as applied to claim 8 above, and further in view of Paschke et al (5395240). The above combination does not show a connection member that uses a connection plug pin. Paschke teaches using a plug pin, Figs. 1-3 and elements 27-29 in Fig. 5. It would be obvious to one of ordinary skill in the art to modify the above combination to include a coupling including pin connectors as shown by Paschke in order to releasably connect the hand tool to electric and fluid sources.

Allowable Subject Matter

If in claim 17, line 7, following "body," - such that the rotator head is adapted to be directly engaged by a user, -, then this and dependent claims would be allowable.

Response to Arguments

Applicant's arguments filed September 24, 2007 have been fully considered but they are not persuasive. With respect to the new claim language added, the language is held to not be a limiting as applicant argues, see suggested claim language above. With respect to the combination with Cook, applicant argues that Cook does not rotate a tool or transducer, however, claims where these elements are not claimed or are only inferentially claimed, this difference is merely intended use with inferentially claimed elements, and as such, is not given patentable weight, and further, as stated before, Cook teaches the rotating structure is for allowing the user to position the device in use to conveniently contact tissue, column 2, lines 30-44. The only difference between claim 15 and Rahman is the location of elements, being located inside or outside the body, as such, the suggestion by Cook that it is known to locate rotation elements outside a portion of the body properly teaches the combination.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722). The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez, can be reached at 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**/John J Wilson/
Primary Examiner
Art Unit 3732**

jw

November 15, 2007